

### **REMARKS**

Claims 1 to 17 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

*Applicants again respectfully request that the Examiner acknowledge in the next Office communication whether the Drawings are accepted.*

With respect to paragraph four (4), claims 1, 2, 7, 9, 10, 15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,207,580 (“Strecher”).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, independent claims 1, 9 and 17 have been revised to better clarify the claimed subject matter.

The Final Office Action asserts that in “Strecher” the collecting of data “about the pattern and history of the health-related behavior” corresponds to a “scenario” (citing column 4, lines 5 to 27) , and further asserts that the pattern and history data are collected by questioning the user (citing column 3, lines 14 to 26).

In the context of the presently claimed subject matter, as presented, the health promotion practitioner support apparatus includes a “storing part” to store the scenarios, an “obtaining part” to obtain data on lifestyles and the level of readiness for change of a client, and a “preparing part” to prepare a health promotion schedule of the client using the scenario that is read from the “storing part” and the data that is obtained by the “obtaining part”.

In contrast (even accepting the assertions of the Final Office Action for purposes of this response), the “Strecher” reference apparently only refers to “obtaining” such data – *but the “Strecher” reference does not in any way disclose or even suggest the “preparing part” for preparing a health promotion schedule using both the obtained data and the scenario, as provided for in the context of the subject matter of claim 1, as presented.*

The reference does not disclose the use of scenarios, as provided for in the context of the claimed subject matter. In particular claim 1 requires the storing of scenarios which includes health promotion information and health promotion timing for each of levels of readiness of change., and the preparing of a health promotion schedule of the client from the scenario and the obtained data. A review of the column 4 text cited in the Office Action provides no support whatsoever for the assertions of the Office Actions to date as to the presently claimed subject matter. In short, the Office has provided no evidence to support the assertion that the use of obtained data and scenarios as provided for in the context of claim 1, as presented and as explained above.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference does not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original). Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). As referred to above, any review of the reference makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claim 1 as presented is allowable for these reasons.

Claims 9 and 17, as presented, include features like those of claim 1 as presented and are therefore allowable for essentially the same reasons as claim 1 as presented.

Claims 2 to 8 depend from claim 1, and are therefore allowable at least for the same reasons as claim 1. Claims 10 to 16 depend from claim 9, and are therefore allowable at least for the same reasons as claim 9.

It is therefore respectfully submitted that claims 1 to 17 are allowable, and that the obviousness rejections of the claims should be withdrawn.

With respect to paragraph five (5), claims 3, 4, 11, and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Strecher” reference in view of the “Rieger” reference.

Claims 3 and 4 depend from allowable claim 1, as presented. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 3 and 4 are allowable for essentially the same reasons as claim 1, and since the “Rieger” reference does not cure the critical deficiencies of the “Strecher” reference, which were explained above. This is because any review of the secondary “Rieger” reference makes clear that it simply does not in any way disclose or suggest the claim 1 features, as explained above. Accordingly, claims 3 and 4 are allowable.

Claims 11 and 12 depend from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 11 and 12 are allowable for essentially the same reasons as claim 9, and since the “Rieger” reference does not cure the critical deficiencies of the “Strecher” reference, which were explained above. This is because any review of the secondary “Rieger” reference makes clear that it simply does not in any way disclose or suggest the claim 9 features, as explained above. Accordingly, claims 11 and 12 are allowable.

With respect to paragraph six (6), claims 5, 6, 8, 13, 14 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Strecher” reference in view of U.S. Patent No. 6,039,688 (“Douglass”).

Claims 5, 6 and 8 depend from allowable claim 1 as presented. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 5, 6 and 8 are allowable for essentially the same reasons as claim 1, as presented, and since the

"Douglass" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Douglass" reference makes clear that it simply does not in any way disclose or suggest the features of claim 1, as presented, as explained above. Accordingly, claims 5, 6 and 8 are allowable.

Claims 13, 14 and 16 depend from allowable claim 9 as presented. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 13, 14 and 16 are allowable for essentially the same reasons as claim 9, as presented, and since the "Douglass" reference does not cure the critical deficiencies of the "Strecher" reference, which were explained above. This is because any review of the secondary "Douglass" reference makes clear that it simply does not in any way disclose or suggest the features of claim 9, as presented, as explained above. Accordingly, claims 13, 14 and 16 are allowable.

It is therefore respectfully submitted that claims 1 to 17 are allowable.

#### Conclusion

It is therefore respectfully submitted that all of claims 1 to 17 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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Respectfully submitted,

By: 

Aaron C. Deditch  
Reg. No. 33,865

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**